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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/653,163  
Filing Date: September 01, 2000  
Appellant(s): MIKITANI ET AL.

\_\_\_\_\_  
Toshikatsu Imaizumi  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 04/09/2009 appealing from the Office action mailed 01/29/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**7(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 2002/0161589 A1	Strandberg	Oct. 31, 2002
US 5,983,196	Wendkos	Nov. 9, 1999

US 6,024,641	Sarno	Feb. 15, 2000
US 6,193,605 B1	Libby et al.	Feb. 27, 2001

## **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, 6, 8-13 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strandberg (US 2002/0161589) in view of Wendkos (US 5,983,196).**

#### *Independent Claims*

Claims 1 and 16, Strandberg teaches a method and system for utilizing a computer network for conducting telemarketing campaign, comprising:

recording means (database 200) for recording information concerning customers, each of which has an electronic mail address [0018];

allocating uniquely an electronic mail address to each of participants [0018]; [0019];

sending by a host a first electronic mail in which an electronic mail address is affixed as a unique access key to each one of a plurality of specified participants [0019];

recognizing said specified participants for a lottery by receiving a second electronic mail sent back to said electronic mail address from each of said participants [0020]; [0023].

Strandberg does not specifically teach that *said telemarketing campaign includes conducting a lottery; that said system includes means for limiting the customers (stored in the database) in advance so as to specify participants for the lottery; and notifying each one of the participants of their result of said lottery.*

Wendkos teaches a method and system for conducting a lottery via the Internet, wherein participants are notified (are send messages to) of their result in said lottery, and wherein said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15 – C. 12, L. 8). Furthermore, Wendkos explicitly teaches identifying a specific group of customers eligible for the lottery from the database of all customers, thereby disclosing the “advance” feature (C. 10, L. 35-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg to include that said telemarketing campaign includes *conducting a lottery*, as disclosed in Wendkos, because it would advantageously stimulate interest of the audience to the campaign, thereby increase participation and potentially increase revenue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include that said system includes *means for limiting the customers in advance so as to specify a main group for performing the lottery*, as disclosed in Wendkos, because it would advantageously allow achieving specific business objectives, including keeping award expenditures within budget and not to waste resources (Wendkos; C. 11, L. 28-30; C. 10, L. 51). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include *notifying each one of the participants of their result of said lottery*, as disclosed in Wendkos, because it would advantageously provide convenience for the participants of not inquiring about the results by themselves.

Claim 10. Strandberg teaches a system for utilizing a computer network for conducting telemarketing campaign, comprising:

storing means for storing information of customers [0018];

means for uniquely allocating a keyword to be entered in a page of a URL, to each of participants [0018]; [0019];

means for sending an electronic mail in which the keyword is affixed as a unique access key, to each of the participants [0019];

means for recognizing an application from each of said participants when said participant accesses the page of said URL and enters the keyword [0020]; [0023].

Strandberg does not specifically teach that said telemarketing campaign includes conducting a lottery; that said system includes means for limiting the customers *in advance* so as to specify a main group for performing the lottery; and notifying each one of the participants of their result of said lottery.

Wendkos teaches a method and system for conducting a lottery via the Internet, wherein participants are notified (are send messages to) of their result in said lottery, and wherein said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15 – C. 12, L. 8). Furthermore, Wendkos explicitly teaches identifying a specific group of customers eligible for the lottery from the database of all customers, thereby disclosing the “advance” feature (C. 10, L. 35-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg to include that said telemarketing campaign includes *conducting a lottery*, as disclosed in Wendkos, because it would advantageously stimulate interest of the audience to the campaign, thereby increase participation and potentially increase revenue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include that said system includes *means for limiting the customers in advance so as to specify a main group for performing the lottery*, as disclosed in Wendkos, because it would advantageously allow achieving specific business objectives, including keeping award expenditures within budget and not to waste resources (Wendkos; C. 11, L. 28-30; C. 10, L. 51). And it would have been obvious to

one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include *notifying each one of the participants of their result of said lottery*, as disclosed in Wendkos, because it would advantageously provide convenience for the participants of not inquiring about the results by themselves.

Claim 17. Strandberg teaches a system for utilizing a computer network for conducting telemarketing campaign, comprising:

storing means for storing information of customers [0018];

means for uniquely allocating a URL to each of participants [0018]; [0019]; means for sending an electronic mail in which the URL is affixed as a unique access key, to each of the participants [0019];

means for recognizing an application from each of said participants when said participant accesses the page of said URL via e-mail [0020]; [0023].

Strandberg does not specifically teach that said telemarketing campaign includes conducting a lottery; that said system includes means for limiting the customers in advance so as to specify a main group for performing the lottery; and notifying each one of the participants of their result of said lottery.

Wendkos teaches a method and system for conducting a lottery via the Internet, wherein participants are notified (are send messages to) of their result in said lottery, and wherein said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15 – C. 12, L. 8). Furthermore, Wendkos explicitly teaches identifying a specific group of customers eligible for the lottery from the database of all customers, thereby disclosing the “advance” feature (C. 10, L. 35-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg to include that said telemarketing campaign includes *conducting a lottery*, as disclosed in Wendkos, because it would

advantageously stimulate interest of the audience to the campaign, thereby increase participation and potentially increase revenue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include that said system includes *means for limiting the customers so as to specify a main group for performing the lottery*, as disclosed in Wendkos, because it would advantageously allow achieving specific business objectives, including keeping award expenditures within budget and not to waste resources (Wendkos; C. 11, L. 28-30; C. 10, L. 51). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include *notifying each one of the participants of their result of said lottery*, as disclosed in Wendkos, because it would advantageously provide convenience for the participants of not inquiring about the results by themselves.

Claims 19, 20 and 21. Strandberg teaches a method and system for utilizing a computer network for conducting telemarketing campaign, comprising:

- storing information of customers in a database [0018];
- specifying participants for the campaign from a database[0018];
- providing at least one electronic mail address [0018];
- allocating uniquely an electronic mail address to each of participants [0018];

[0019];

sending by a host a first electronic mail in which an electronic mail address is affixed as a unique access key to each one of a plurality of specified participants [0019];

recognizing said specified participants for a lottery by receiving a second electronic mail sent back to said electronic mail address from each of said participants [0020]; [0023].

Strandberg does not specifically teach that said telemarketing campaign includes conducting a lottery; that said system includes means for limiting the customers in advance so as to specify a main group for performing the lottery; and notifying each one of the participants of their result of said lottery.



Wendkos teaches a method and system for conducting a lottery via the Internet, wherein participants are notified (are send messages to) of their result in said lottery, and wherein said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15 – C. 12, L. 8). Furthermore, Wendkos explicitly teaches identifying a specific group of customers eligible for the lottery from the database of all customers, thereby disclosing the “advance” feature (C. 10, L. 35-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg to include that said telemarketing campaign includes *conducting a lottery*, as disclosed in Wendkos, because it would advantageously stimulate interest of the audience to the campaign, thereby increase participation and potentially increase revenue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include that said system includes *means for limiting the customers so as to specify a main group for performing the lottery*, as disclosed in Wendkos, because it would advantageously allow achieving specific business objectives, including keeping award expenditures within budget and not to waste resources (Wendkos; C. 11, L. 28-30; C. 10, L. 51). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include *notifying each one of the participants of their result of said lottery*, as disclosed in Wendkos, because it would advantageously provide convenience for the participants of not inquiring about the results by themselves.

#### Dependent Claims

Claims 2-4, 6, 11-13, 18 and 22, see reasoning applied to claims 1, 10, 16, 17, 19 and 20.

**Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strandberg in view of Wendkos and further in view of Sarno (US 6,024,641).**

Claim 8. Strandberg in view of Wendkos teach all the limitations of claim 8, except specifically teaching that the URL of the page informing of said result is separated into one for a win of a prize and the other for a failure in winning the prize.

Sarno teaches a system for on-line lottery gaming, including means for registering participants for said lottery via a Web site, means for conducting said lottery and means for notifying said participants of a result of said on-line lottery, wherein said means for registration includes means for entering an electronic address of a participant (C. 7, L. 23-26) and wherein said means for notification includes means for sending said notification via an electronic mail (C. 6, L. 14-16), and further wherein the URL of the page informing said result is separated into one for a winner of a prize and the other for a loser in winning the prize (Figs. 3B, 6; C. 6, L. 14 – C. 7, L. 32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg in view of Wendkos to include that the URL of the page informing said result is separated into one for a winner of a prize and the other for a loser in winning the prize, as disclosed in Samo, because it would advantageously allow to simplify reading of the lottery results.

Claim 9, Samo teaches said system and method wherein by entering said access keyword and a mail address to which said access keyword is sent into the page informing said result, a page for the winner of the prize and a page of the loser in winning the prize can be accessed (C. 6, L. 14 – C. 7, L. 32). The motivation to combine references would be to simplify the access to the results of the lottery.

**Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strandberg in view of Wendkos and further in view of Libby et al. (US 6,193,605).**

Claims 23-26, Strandberg in view of Wendkos teaches all the limitations of claims 23-26, except specifically teaching that that said means for conducting the lottery generates random number on the basis of the number of said participants, thereby obtaining the results of the lottery.

Libby et al. teaches a lottery system, wherein the identities of the grand prize participants may be stored in, for example, a grand prize data table (step 318) and the winner of the grand prize may be randomly selected by the random number generator 38 (step 320). Once the winner of the grand prize is selected, the name of the winner is broadcasted after the race (step 322) (C. 7, L. 62 – C. 8, L. 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg in view of Wendkos to include that that said means for conducting the lottery generates random number on the basis of the number of said participants, thereby obtaining the results of the lottery, as disclosed in Libby et al, because it would advantageously facilitates the conducting of said lottery.

#### **(10) Response to Argument**

##### **(10.01)**

##### **(a) Claims 1-4, 6, 8, 9, 12 and 13** **Appeal Brief (AB) p. 12**

**Applicant argues** that Wendkos fails to teach “means for limiting the customers stored in the stored means in advance so as to specify particular participants for a lottery”, and “On the other hand, Wendkos does not limit the customer before the lottery is performed”.

**In response to this argument** it is noted that Wendkos explicitly discloses this feature. Specifically, Wendkos teaches that only selected participants, who have made certain amount of purchases, are selected to participate in promotion/lottery (C. 10, L. 35-53):

A particularly powerful use of this capability is found under the circumstance when a sponsor of a promotional program wishes to identify his "good customers." A good customer might be defined as a customer who has made three purchases of a particular type in the last thirty days. By invoking the name and address capture routine of FIGS. 11A and 11B, only for those participants who have registered certificates for the three purchases in question within thirty days, the sponsor of the program can receive a list of names and addresses which contain only those customers who have made such purchases. In the prior art, a sponsor of a program was limited to either capturing everyone's name and address, or no one's. This permits the name and address capture to be customized to the needs of the particular sponsor. As a result, since the cost of direct mailings is very high, the sponsor can customize a mailing to only his best purchasers, however the sponsor may define that term. As a result, a sponsor will not waste resources in conducting a direct mailing to customers who might not be responsive to his entreaties.

AB p. 13

**Applicant argues** that "(ii) Examiner's error in determining that Wendkos explicitly teaches identifying a specific group of customers".

**In response to this argument** the examiner maintains that Wendkos discloses this feature (C. 10, L. 35-53):

A particularly powerful use of this capability is found under the circumstance when a sponsor of a promotional program wishes to identify his "good customers." A good customer might be defined as a customer who has made three purchases of a particular type in the last thirty days. By invoking the name and address capture routine of FIGS. 11A and 11B, only for those participants who have registered certificates for the three purchases in question within thirty days, the sponsor of the program can receive a list of names and addresses which contain only those customers who have made such purchases.

As one can see from this paragraph, the sponsor can identify those participants who have fulfilled certain requirements.

AB p. 14.

**Applicant argues** that “However, although Wendkos teaches that customer information may be used for selection of customer for direct mailings, it does NOT teach that participants are selected from the customer information.”

**In response to this argument** the examiner points out that information collected about the customers in Wendkos’ system is utilized for to promotional program/lottery (Figs. 11B, 12; C. 9, L. 54-58; C. 10, L. 35-39; C. 11, L. 1-5). Based on the customer information, the participants are selected; the promotion messages are played; and awards are distributed in a controlled manner. Wendkos teaches, that “Each user who interacts with the interactive platform essentially engages in a lottery with a controlled probability of an award...” (C. 5, L. 1-5).

Wendkos further teaches, that, in the end, participant information is used to identify and award the winners (C. 10, L. 56-67):

As with the other processes, the smart win process begins with a call from the call flow table (1200) passing state and/or participant information. In this case, it may also pass certificate information such as a certificate ID (1210). With certificate ID information, certificate information from the certificate data base may be retrieved. A particular award algorithm is selected (1220) based on certificate information and/or participant information as discussed more hereinafter. If the participant is a winner, the award amount is credited (1230) and the process returns. The function of the smart win process is to make awards to certain participant in a controlled manner.

AB p. 15

**(2) Applicant argues** that "Examiner's error in determining that Strandberg teaches a ... system... comprising:...allocating uniquely a reply electronic mail address to each of participants".

**In response to this argument** the examiner points out that the main purpose of allocating uniquely said reply electronic mail addresses to each of said participant is that said reply electronic mail addresses are different from each other (claim language), or that each participant can be recognized. Strandberg teaches allocating a unique ID (to be inserted into participants' reply e-mail) to each of the participants so, that each participant can be recognized by this ID in his/her reply e-mail [0019]. Accordingly, so as the purpose of allocating the unique ID in Strandberg's system is the same as allocating the unique e-mail address in the applicant's invention, the examiner maintains that teaching of Strandberg is equivalent to the inventive feature in question.

**(10.02)**

**(b) Claims 10, 11 and 18**

AB p. 16

1. **Applicant argues** that "Examiner's error in determining that Wendkos teaches means for limiting the customers so as to specify a main group for performing the lottery...".

**In response to this argument** it is noted that this argument essentially repeats the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments (See Wendkos, C. 10, L. 35-53:

A particularly powerful use of this capability is found under the circumstance when a sponsor of a promotional program wishes to identify his "good customers." A good customer might be defined as a customer who has made three purchases of a particular type in the last thirty days. By invoking the name and address capture routine of FIGS. 11A and 11B, only for those participants who have registered certificates for the three purchases in question within thirty days, the sponsor of the program can receive a list of names and addresses which contain only those customers who have made such purchases.)

2. **Applicant argues** that "Examiner's error in determining that Strandberg teaches means for uniquely allocating a keyword to be entered in a page of a URL, to each of participants.

**In response to this argument** it is noted that this argument essentially repeats the arguments presented above in respect to "allocating uniquely a reply electronic mail address" feature; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

**(10.03)**

**Claims 16, 17, 19, 20, and 21-26**

AB pp. 15-19

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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